



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
---------------	-------------	----------------------	---------------------

08/078,768 06/16/93 TULLIS

R FMR9/58
EXAMINER

MARTINELL, J

ART UNIT PAPER NUMBER

31

18M2/1128
TOWNSEND & TOWNSEND, KHOURIE & CREW
ONE MARKET
STEWART STREET TOWER
20TH FLOOR
SAN FRANCISCO, CA 94105

1804
DATE MAILED:
11/28/94

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☒ Responsive to communication filed on 08/22/94 + 09/06/94 ☒ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), — days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152. |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 64-72 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☒ Claims 1-63 have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 64-72 are rejected.

5. ☐ Claims _____ are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☒ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

BEST AVAILABLE COPY

Serial No. 08/078,768

Art Unit 1804

This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claims 64-72 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to the preparation and use of stabilized forms of oligodeoxyribonucleotides that are phosphotriesters. See M.P.E.P. §§ 706.03(n) and 706.03(z). This rejection is repeated for reasons already of record. Applicant's arguments (paper no. 28) and the declarations by Drs. Ruth and Schwartz (filed September 6, 1994) are not convincing. The arguments and declarations do not address the issue of stability of the oligodeoxyribonucleotides *in vivo* (the declarations are silent on this issue). Paper no. 28 at page 5, first full paragraph asserts that the use of a stabilized nucleic acid is not the inventive principle of the instant invention and that any nucleic acid will work in the claimed method. This argument is most unconvincing in view of the argument made by applicant in the parent application (see patented file of U.S. Patent No. 5,023,243, paper no. 8 (filed February 9, 1984), page 3) wherein applicant says of a reference, "Zamecnik and Stephenson used an unprotected oligonucleotide, which would break down in vivo before having the desired effect." Thus, applicant's current assertion that any nucleic acid will work is in conflict with applicant's earlier statement.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

Serial No. 08/078,768

Art Unit 1804

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Certain papers related to this application may be submitted to Group 1800 by facsimile transmission. Papers should be faxed to Group 1800 at (703) 305-3014. The faxing of such papers must conform with the rules published in the Official Gazette, 1156 OG 61 (November 16, 1993).

Any inquiry concerning this communication should be directed to J. Martinell at telephone number (703) 308-0296.

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1804.


JAMES MARTINELL, PH.D.
SENIOR LEVEL EXAMINER
GROUP 1800

BEST AVAILABLE COPY